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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,343	10/16/2003	Tatsuya Ishizuka	14867B	7857

7590 11/23/2005

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EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/687,343

Applicant(s)

ISHIZUKA, TATSUYA

Examiner

John P. Leubecker

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/931,847.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/16/03</u>  | 6) <input type="checkbox"/> Other: _____                                    |

***Specification***

1. The disclosure is objected to because of the following informalities: the status of the parent application referenced in the first paragraph of the specification, as amended, needs to be updated.

Appropriate correction is required.

***Claim Objections***

2. Claim 14 is objected to because of the following informalities: “the atmospheric pressure” should just be “atmospheric pressure”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 14, terms “the surface” and “the housing” lack antecedent basis.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Higuma et al. (U.S. Pat. 6,547,721).

Higuma et al. disclose an endoscope comprising an elastic member (rubber o-ring 23, Fig.2) having at least a part thereof engaged with a surface of a housing (21,22, Fig.2) under atmospheric pressure so that the endoscope will be kept fluid-tight (col.7, lines 51-59), wherein said elastic member includes a seal portion (24) that separates from the surface of the housing under predetermined pressure that is oriented from the inner surface of the elastic member to the outer surface thereof (col.7, lines 42-50).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Higuma et al.

Higuma et al. discloses that the seal portion (24) can be made of a metal, *for example* (col.7, lines 25-27) and thus Higuma et al. fails to mention that the seal portion comprises a resin material. Since most medical or surgical instruments are made of either biocompatible metals or

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biocompatible plastics (which includes resins), one of ordinary skill in the art would not consider use of either of these groups of materials novel. Since making the seal portion (24) out of resin (plastic) instead of metal would be lighter, less expensive (since it is commonly known that plastics are cheaper to manufacture than metals) and easier to make (e.g. molding a resin is generally accepted as being easier than machining metal), it would have been obvious to one of ordinary skill in the art to have made the seal portion (24) of Higuma et al. out of a resin material.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hosono et al. (U.S. Pat. 4,341,205)—note elastic member (38) which is sealed to the housing and expands (e.g., separates from the housing) due to the pressure of the internal fluid (e.g., predetermined pressure), meeting at least claim 1.

Chikama (U.S. Pat. 4,986,257)—note sheath tube (5) which seals hole (16) for sterilization. A high pressure (e.g., predetermined pressure) would inherently cause the sheath tube to separate from endoscope housing (1), meeting at least claim 1.

Konstorum et al. (U.S. Pat. 6,475,140)—note teaching of a relief valve for relieving internal sterilization pressure and rupturing (e.g., separating) of the insertion tube cover (col.1).

Also note the following which show a balloon (e.g. elastic member) engaged with a housing (e.g., insertion tube) which, under predetermined pressure (e.g. inflation pressure), will expand (e.g. separate) away from the housing:

Weber et al. (U.S. Pat. 6,659,941)

Madni et al. (U.S. Pat. 6,007,482)

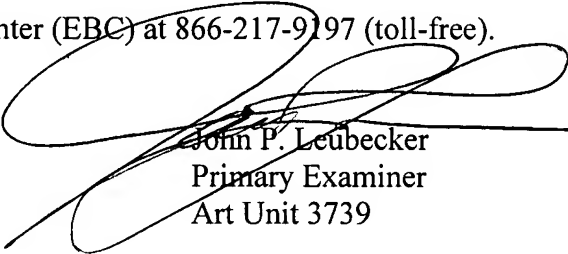
Rosenbluth et al. (U.S. Pat. 5, 836,951)

Ono et al. (U.S. Pat. 4,681,093)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl